

REMARKS

Applicants respectfully request favorable reconsideration of the above-captioned application.

This application has been carefully reviewed in light of the Office Action dated December 20, 2005. In that Office Action, the Examiner kindly pointed out that claim 76 was inadvertently omitted, and required appropriate correction. Therefore, in this Amendment, claims 77-81 have been cancelled without prejudice and claims 82-86 have been substituted therefore. Claims 82-86 are identical to cancelled claims 77-81 except for the claim numbers, and the dependencies have been correspondingly addressed. No other claim amendments have been made. Therefore, claims 41-75 and 82-86 are now pending in this application. Claims 41 and 60 are independent.

In the Office Action, claims 51-58 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, these claims recite “Investor/Goal Manager” and “Profile/Asset” screens, the nature of which is alleged to be unclear. Similarly, claims 72-74 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite as reciting an “Investor/Goal Manager” screen, the nature of which is alleged to be unclear.

Applicants respectfully traverse these rejections. Figure 4 is expressly defined as illustrating an Investor/Goal Manager screen configured in accordance with at least one embodiment of the invention (see Paragraph 14). As further described in at least Paragraph 53, the Investor/Goal Manager screen 400 acts as the location from which all investor, goal, and account icon functions are executed within the Advisor. Even more specifically, Paragraph 53 states that this screen is configured to display all accounts associated with the investor as well as

their financial goals and an indication of their progress toward attaining these goals. Further detailed description is given in Paragraphs 53-70, with detailed description as to how to use the icons and what the results of triggering the icons are. It is respectfully submitted that these pages of description, together with the actual illustration of the Investor/Goal Manager screen 400 in Figure 4, provide more than enough substantial and specific information to satisfy the requirements of Section 112, second paragraph.

Correspondingly, Figure 8 illustrates an example of the “Profile Asset Allocation” screen configured in accordance with at least one embodiment of the invention. Detailed and specific information as to the content and operation of this screen are found, for example, in paragraphs 99-105. Again, it is respectfully submitted that these pages of description, together with the actual illustration of the “Profile Asset Allocation” screen in Figure 8, provide more than enough substantial and specific information to satisfy the requirements of Section 112, second paragraph.

If the Examiner maintains this rejection, he is respectfully requested to state exactly in what way the nature of these illustrated screens is unclear.

In the Office Action, independent claims 41 and 62, together with various dependent claims, were rejected under 35 U.S.C. 103 over U.S. Patent 5,918,217 (Maggioncalda et al.) in view of US 2003/0208427 (Peters et al.). Others of the dependent claims were rejected as being obvious over Maggioncalda et al. and Peters et al. U.S. Patent 6,430,542 (Moran).

Applicants respectfully traverse and submit that independent claims 41 and 62, which are corresponding system and method claims, are patentably distinct from the cited prior art for the following reasons.

The Office Action cites to Maggioncalda, primarily as to certain physical structures recited in claim 41, such as a front-end including a plurality of graphical user interfaces and a

back-end configured to identify one or more recommended investments and an allocation of funds. Without conceding that Maggioncalda actually does disclose all that the Office Action proposes, Applicants wish to address those aspects of claim 41 that the Office Action expressly admits are not disclosed by Maggioncalda, but are allegedly disclosed by Peters.

Claim 41 recites, *inter alia*, that:

“the front-end displays on a graphical user interface a current allocation of the at least one investor account among the plurality of investments, the risk allocation of the at least one investor account among the plurality of investments, a target allocation of the at least one investor account among the plurality of investments and the designated goal, wherein the target allocation is an allocation of the at least one investor account among the plurality of investments chosen by the user.”

In other words, claim 41 *requires* the display of *three* allocations:

- (1) a current allocation of the at least one investor account among the plurality of investments;
- (2) the risk allocation of the at least one investor account among the plurality of investments; and
- (3) a target allocation of the at least one investor account among the plurality of investments.

These three *different* allocations are shown, for example, in Figure 10 (i.e., the second, third and fourth columns in the array 1004). In the particular example of Figure 10, the risk allocation and the target allocation have the same values, because the investor’s risk and investment profile have already been analyzed and formulated, so that the Advisor enables the user to select an asset allocation directed towards specific goal objectives (see Paragraph 111,

page 22). Paragraph 111 expressly states that this Allocation Strategies screen 1000 (emphasis added):

“displays data indicating an investor’s goal value by asset class according to current allocation, risk profile allocation and the *adjustable* investor target allocation in either percentage or dollar values.”

Thus these three allocations represent different data, and in particular there is no reason to assume that the risk profile allocation and the *adjustable* investor target allocation are the same information.

However, this is apparently what the Office Action does. Specifically, at page 4, the Office Action states (emphasis added):

“Given that the Applicant’s specification and drawings show that the risk profile allocation and target allocation are *identical* (See Fig. 14 of instant application), both read as the target allocation (Suggested Holdings”, Fig. 18 of Peters). This is a logical understanding, as one would want the target allocation to be a reflection of the allocation resulting from the users specified risk tolerance, one would want a target to reflect the desired risk.”

Applicants understand the Office Action to be admitting that Peters discloses in Fig. 18 only two allocations, not the three allocations recited in claim 41, and therefore seeks to read one of the three allocations recited in claim 41 out of the claim. Applicants strongly disagree with this analysis. First, there is absolutely no basis in patent law for reading an entire limitation out of a claim. If the Examiner is aware of any authority to the contrary, he is respectfully requested to identify it.

Second, Applicants specification and drawings do **not** show that risk profile allocation and target allocation are identical. A user may be willing to tolerate certain risks in order to reach certain target goals, and the allocations of investments may have to be adjusted and/or risks and goals re-evaluated in order to reach a current allocation that seems to be the best compromise

at the moment, but that does not mean that these allocations are inherently identical. What the Examiner appears to be doing is looking at the final result, i.e., the ultimate current allocation that is the best compromise, and assuming that because the best compromise was desired from the start, it was also known from the start. To the contrary, these allocations represent different parts of the puzzle and are used together, in accordance with the present invention, to achieve the highly advantageous result described in the specification.

Applicants repeat: claim 41 expressly recites the display of three allocations, described in different terms having different meanings. Applicants submit that it is improper claim analysis to state that two of these allocations, *expressly defined in different terms*, must be identical and therefore can be read onto a single element of a reference.

Applicants further submit that there is nothing in the references to *Maggioncalda et al.* and *Moran*, taken individually or in combination, to remedy the above described deficiencies of *Peters* in failing to teach or suggest the output display of three allocations, in context with the remaining claim features, as recited in claim 41. Applicants have reviewed the remaining prior art of record and have found nothing therein that would remedy the deficiencies of *Peters*, *Maggioncalda et al.* and *Moran* as references against claim 41.

Accordingly, Applicants respectfully submit that independent claim 41, together with the claims dependent thereon, is patentably distinct from the cited prior art.

The present invention as defined in independent claim 62 is directed to a method corresponding to the system of claim 41 and includes corresponding distinguishing recitations. Accordingly, Applicants respectfully submit that independent claim 62, together with the claims dependent thereon, is patentably distinct from the cited prior art.

In view of the above amendments and remarks, Applicants respectfully submit that

claims 41-75 and 82-86 are patentably distinct from the prior art of record. The Examiner is respectfully requested to pass this case to issue.

If any fee is due for this filing, please charge the LARGE ENTITY fee therefor to Deposit Account No. 16-2500 of the undersigned.

Applicants' undersigned attorney may be reached by telephone at (212) 969-3000 or by facsimile at (212) 969-2900. Please direct all correspondence to Customer No. 21890 at the address provided below.

Respectfully submitted
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